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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/647,419	08/25/2003	Yoshihiro Yazawa	1374-DIV-01	2814

35811 7590 03/15/2006

IP GROUP OF DLA PIPER RUDNICK GRAY CARY US LLP  
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EXAMINER

MCNELIS, KATHLEEN A

ART UNIT	PAPER NUMBER
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1742

DATE MAILED: 03/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/647,419	<b>Applicant(s)</b> YAZAWA ET AL.	
	<b>Examiner</b> Kathleen A. McNelis	<b>Art Unit</b> 1742	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 09 January 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 5-8 and 27-34 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 5-8 and 27-34 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **Claims Status**

Claims 5-8 and 27-34 remain for examination wherein claims 31-34 are new.

### **Status of Previous Rejection**

The previous rejection of claims under 35 U.S.C. 103(a) is withdrawn in view of applicants' arguments.

### **DETAILED ACTION**

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not

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commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 5 to 8 and 27-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over European patent 1113084 (EP '084) or Takahashi et al. (U.S. Pat. No. 6,645,318) in view of Kawanishi et al. (U.S. PG Pub. No. 2001/0005549).

EP '084 and Takahashi are applied to claims 5 to 8 as stated in the September 30, 2005 office action. Further, regarding claims 31-34:

- EP '084 Table 4, page 15 discloses an r-value of 2.15 which is close to the claimed range of 2.2 or greater in new claims 31-34. It has been well settled that where claimed ranges and prior art ranges do not overlap but lie close enough that one of ordinary skill in the art would expect the same properties to result, a prima facie case of obviousness exists (M.P.E.P § 2144.05); and
- Takahashi et al. discloses r values of 2.20 and greater (columns 8 -10) as in new claims 31-34.

EP '084 and Takahashi et al. do not disclose bake coating the ferritic stainless steel sheet with a lubricant coat comprising an acrylic resin, calcium stearate and polyethylene wax in a coating amount of about 0.5 to 4.0 g/m.<sup>2</sup>

Kawanishi et al. discloses a lubricated steel material with lubricating film having good press formability, removability and blocking resistance as well as rust preventing properties (abstract), wherein the coating is applied to stainless steel sheets (¶ 0001). The lubricant comprises acrylic resin (¶ 0022) and one or more of a water repellant lubricant, selected from a group of 4 materials including metal soaps and polyethylene fine powder (¶ 0026), wherein calcium stearate is given as an example of a metal soap (¶ 0028).

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Further, Kawanishi et al. discloses that the coating weight should be in the range of from 0.2 to 6.0 g/m<sup>2</sup>, preferably from 0.5 to 3.0 g/m<sup>2</sup> (¶ 0043), where the preferred range of 0.5 to 3.0 g/m<sup>2</sup> is within the claimed range of from about 0.5 to 4.0 g/m<sup>2</sup>. The coating is applied wet then dried (i.e. baked) at a temperature of between 50 and 150 °C. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the lubricant film as taught by Kawanishi et al. on the steel of EP '084 or Takahashi et al. to provide good press formability, removability and blocking resistance as taught by Kawanishi et al.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kathleen A. McNelis whose telephone number is 571- 272-3554. The examiner can normally be reached on M-F 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King can be reached on 571-272-1244. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ROY KING   
SUPERVISORY PATENT EXAMINER  
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